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creating, by using a first computer code segment, at least one list of multiple works;

downloading, by using a second computer code segment, at least some of the works on the list from a remote source, via a communications network that is available at least intermittently, to a user station.

REMARKS

Reexamination and reconsideration of the above-identified application are hereby requested. A number of allowable new claims have been added by this Amendment. In the Office Action, the Examiner rejected claims 30-45 as anticipated by Contois. For the following reasons, there is no anticipation of those claims.

In Contois, to the extent that a play list can be edited, the process is carried out on two different screens. Figures 2-4 illustrate one type of screen which permits a user to add songs to a list. The list is clearly illustrated in the lower left section of the screen in each case.

Fig. 5 illustrates a different screen, one which only lists "selected songs" but which provides a delete function and a clear function. In support of the rejection, the Examiner has referred to col. 5, lines 6-25. However, a review of that section of text provides no discussion whatsoever of editing features or editing structure.

In contrast, col. 11, lines 30-67, describes a completely different editing structure, which is consistent with Figs. 2-4 and 5 of Contois but which is quite different from the claimed structure. As noted in col. 11:

"In operation, once a piece of music is selected, a user may activate the button labeled 'Add to Song List' (see Figs. 2-4) which is located at the bottom center of each screen. By using this button, a user can create their own personal record album or compact disk which contains only those songs that have been individually selected. Thereby, the player piano can be directed to play each song one after the other in sequence or in a random order.

Once a list of songs has been selected, using the 'Add to Song List' button the user can view, customize, and edit the created list. A user selects 'File' from the menu

bar as illustrated in Fig. 4, and selects 'Song List' or by actuating the control and S key simultaneously." (Col. 11, lines 32-43).

The above processes are reflected in Figs. 2-4 is limited to permitting a user to add songs to a list. No other processing in the nature of editing is permitted. Nor do any of these screens disclose the presence of "additional instructions for creating an editing command overlay for editing the displayed list of works" as claimed. Additionally, with respect to Fig. 5, Contois states:

"Fig. 5 illustrates a basic Song List screen with the associated operational buttons. Note, that the songs listed under the Selected Songs heading (Moonlight Sonata, As Time Goes By, and the Entertainer) were recently added to the song list. The user has several options to use on these newly listed songs. First, by activating the "Save Long List" button, the user can save the song list and give the list a name that could be used latter [sic] to both identify and access this newly created list. Second, by activating the Play Song List button, the user could also play the displayed list of songs on the player piano without ever having saved the created song list. Third, the user could edit the song list by using the 'Delete Song' button thereby eliminating any song that was highlighted or selected." (Col. 11, lines 45-58).

As was the case with the screens of Figs. 2-4, the screen of Fig. 5 is completely devoid of any overlay. Thus, for all of the above reasons, Contois does not meet each of the limitations of claims 30-45.

The screens of Figs. 2-4 which are similar and Fig. 5 along with the underlying executable instructions and the text of Contois noted above makes it clear that Contois has produced an editing process which incorporates one screen for adding songs to a play list and a different screen for deleting songs from a play list. Contois thus uses alternate or different screens to carry out an editing process which is quite different and unlike the claimed apparatus. Hence, Contois cannot anticipate pending claims 30-45. Withdrawal of that rejection is respectfully requested.

Additionally, the Examiner rejected claims 35 and 38 arguing that Contois teaches "'analysis of the characteristics of works on a selected list" (see col. 9, lines 42-66).' A review of the noted text discloses no reference whatsoever the "sorting works in accordance with a pre-selected parameter". The text in question describes the way in which a user can "view all of the available data in each data field before making any item selections" (col. 9, lines 48-51). The remainder of the text as noted below is not directed to works on a selected list. Rather, it refers to categories into which groups of works can be accumulated. From various categories, a user can create one or more lists. As stated by Contois:

"Displayed on the user interface screens of Figs. 2, 3, 4 and 6 are four categories of data that may be accessed from the player piano data base. Specifically, the data base categories are labeled as: Category (a short form for music category), Composer, Artist and Selected Songs. Located below each data base category is a respective data field that list [sic] the items or data found in the data base that are associated with the particular category. A description of each data field will now be provided.

The data field labeled as "Category," as the title signifies, displays all of the general music category items found in the data base. For example, blues, Christmas, classical, gospel, jazz, pianosoft, and ragtime music category items are illustrated." (Col. 9, lines 53-66).

Thus, for the above additional reasons, the rejections of claims 35 and 38 should be withdrawn. Similar comments apply to the rejections of claims 36 and 37.

In rejecting claim 38 as anticipated by Contois, the Examiner referred again to col. 9, lines 42-66. The system of claim 38 is simply not referred to in col. 9, lines 42-66. As such, Contois cannot anticipate same.

It is also submitted that the rejections of claims 40-45 as anticipated are inappropriate and should be withdrawn. With respect to claim 40, Contois merely discloses an inventory list of sorted by categories, see Figs. 2-4. Users must select songs for a list by means of the "Add to Song List" button present on the screen of each Figs. 2-4. The system as claimed is simply not

disclosed in Contois which requires manual involvement by the user in selecting each song for a list. As described by Contois:

"For example, regarding Fig. 3, by selecting Beethoven as shown, all of the other data fields may be directed to only display data found in the data base that pertains to the composer Beethoven. The user may now display only items in the Artist and Selected Songs categories that are related to Beethoven. By providing a user with these features, hundreds or thousands of items are eliminated from being displayed on the user display thereby allowing the user to more easily make selections of music to be played upon the player piano." (Col. 10, lines 27-36).

As the above quote makes clear, it is the user who is directing the selection in Contois which is unlike the system of claims 40-45. For at least the above reasons, Contois does not anticipate those claims. It is requested that the rejection of those claims be withdrawn.

Additionally, with respect to claim 45 and the rejection thereof, it is noted that Contois makes no reference whatsoever to "presenting downloaded advertisements". Hence, for this additional reason, claim 45 is also allowable.

The Examiner has rejected claims 46-66 as obvious and unpatentable over Contois read in view of Bernard et al. We first note that the system of Contois is quite different from and has a completely different purpose than does the system of Bernard et al. Contois deals with a particular form of a system enabling a user to create executable play lists for an output device such as a player piano. Contois discloses obtaining works from a local disk drive 28 connected to processor 30. Bernard et al is a product purchasing system wherein the preferred embodiment is a telephone based call-in system where a user interacts audibly, and with a telephone key pad, to voice response units for purposes of placing orders for media such as CD's or the like. As with any form of an automated purchasing system, provision is made to enable a user to pay for the acquired products, such as by use of a credit card account. As noted therein:

"If the purchaser is a 'member' of the purchasing service, the purchaser has a profile on file which indicates the pertinent information such as the purchaser's delivery address, shipment

preferences, credit, debit card or billing information, and other like information. ... because a non-member does not have a membership profile, the non-member will speak to a sales representative to complete the sale. At this time, the sales representative obtains payment and delivery information from the purchaser to complete the sale. (Col. 10, lines 39-56).

As described above, Bernard et al is a product purchasing system which can be used to acquire CD-type media. We first note that it is inappropriate to combine Contois and Bernard et al as has been done by the Examiner. The two systems represent non-analogous prior art. On the one hand, Contois discloses a system for creating play lists which can be executed. It does not address selling a product. On the other hand, Bernard et al is an automated, audio based sales system whose intent and purpose is to facilitate the sale and transfer of product.

Nothing about either of Contois or Bernard et al suggests combining one with the other except for the teachings of the present application. Use of the present application to create a rationale for an obviousness rejection is clearly a form of hindsight reconstruction which is improper. Additionally, the Examiner stated "Bernard et al teaches "royalty payment, or, billing information" (see col. 7, lines 38-55)." However, col. 7, lines 38-55 deal with a brief description of several of the figures of the Bernard et al patent. Neither the brief description nor the figures address royalty payment or billing information.

The Examiner further concluded that "It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Bernard "royalty payment, or billing information" (see col. 7, lines 38-55) with the teachings of Contois above, because using the steps of royalty payment, or, billing information" would have given those skilled in the art the tools to track and gauge the purchasing of musical items." (Page 4, numbered section 5 of the Office Action).

The above conclusory statement, in the absence of "royalty payment, or, billing information" in col. 7, lines 38-55, simply does not support the rejection of claims 46-66. Contois does not address purchasing of musical items. There is no need for Contois to address this issue absent the teachings of the present application. Bernard et al addresses selection, payment and delivery of products. Bernard et al is completely silent as to creation of play lists.

None of the above supports the Examiner's combination and conclusion of obviousness for the above reasons.

In connection with the rejection of claim 49, Bernard et al does not maintain "information as to popularity of various works" as claimed. With respect to the rejection of claim 50, Bernard et al does not include "instructions for presenting advertisements" as claimed. With respect to the rejection of claim 56, neither Contois nor Bernard et al include "executable instructions for selecting a plurality of works in accordance with a predetermined performance parameter". The categories of Contois, see Fig. 2 thereof, cannot correspond to the claimed "predetermined performance parameter". Bernard et al is completely silent relative to parameters of products for sale. In connection with the rejection of claim 57, neither Contois nor Bernard et al addresses "executable instructions select works in accordance with a pre-specified beats for time interval."

Turning to the rejection of claim 58, the defects in the rationale for this rejection were previously discussed relative to claims 30 and 46. Additionally, claim 58 includes "executable instructions for executing the play list and for maintaining popularity information pertaining to works from at least one executed play list." Both Contois and Bernard et al are completely silent relative to the quoted feature from claim 58.

As noted previously with respect to the rejection of claim 50, the rejection of claim 60 would appear to have no basis in that neither Contois or Bernard et al taken alone or in combination. Neither addresses "executable instructions for presenting advertisements." as claimed. The rejection of claim 62 does not address the feature that "the criterion corresponds to beats per unit time and the executable instructions select works in accordance therewith. Thus for all of the above reasons, claims 58-62 are allowable.

In rejecting claim 63, the Examiner appears to have ignored the claimed "executable instructions for executing the play list and for displaying advertisements". The only suggestion for the claimed feature of claim 63 comes from the present application. As such the conclusion of obviousness represents a form of hindsight reconstruction and is improper. Additionally, claim 65 adds the further limitation that "the criterion corresponds to beats per unit time and the executable instructions select works in accordance therewith." As noted previously with respect to claim 57, both Contois and Bernard et al are silent with respect to the claimed feature.

For the above reasons, the rejection of claim 66 as obvious is also improper and should be withdrawn. Neither of Contois nor Bernard et al suggest, disclose or make obvious the claimed:

"executable instructions for creating at least one play list by selecting works in accordance with a predetermined criterion; and executable instructions for executing the play list and for maintaining information pertaining to at least one of billing information; royalty payments and popularity of works."

For all of the above reasons, the pending claims along with the newly added claims are deemed to be allowable. Allowance of the application is respectfully requested.

Respectfully submitted,

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